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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,174	03/21/2001	Agustin Alberto deROJAS	39015-002 2803	
Proskauer Rose LLP			EXAMINER	
Patent Departm 1585 Broadway	,		MARKHAM, WESLEY D	
New York, NY 10036			ART UNIT	PAPER NUMBER

1762 DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
*	Application No.					
Office Action Summary	09/814,174	DEROJAS ET AL.				
omec Action Guillinary	Examiner	Art Unit				
The MAILING DATE of this communication app	Wesley D Markham  ears on the cover sheet with the o	1762				
Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period with a Failure to reply within the set or extended period for reply will, by statute, any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).  Status	6(a). In no event, however, may a reply be tir within the statutory minimum of thirty (30) day ill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	nely filed  s will be considered timely. the mailing date of this communication. D (35 U.S.C. § 133).				
1) Responsive to communication(s) filed on						
2a)☐ This action is <b>FINAL</b> . 2b)⊠ Thi	s action is non-final.					
3) Since this application is in condition for allowa						
closed in accordance with the practice under <i>E</i> <b>Disposition of Claims</b>	ex parte Quayle, 1955 C.D. 11, 4	100 U.G. 213.				
4) Claim(s) 1-29 is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6) Claim(s) is/are rejected.	6) Claim(s) is/are rejected.					
7) Claim(s) is/are objected to.						
8) Claim(s) 1-29 are subject to restriction and/or election requirement.						
Application Papers  ON The specification is objected to by the Examiner						
9) The specification is objected to by the Examiner.  10) The drawing(s) filed on is/are: a) accepted or b □ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner.						
If approved, corrected drawings are required in reply to this Office action.						
12)☐ The oath or declaration is objected to by the Examiner.						
Priority under 35 U.S.C. §§ 119 and 120						
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No						
<ul> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>						
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).						
a)  The translation of the foreign language prov 15) Acknowledgment is made of a claim for domestic						
Attachment(s)						
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5) 🔲 Notice of Informal I	y (PTO-413) Paper No(s) Patent Application (PTO-152)				

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## **DETAILED ACTION**

## Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - Claims 1 16, drawn to a process for producing a photochromic lens, classified in class 427, subclass 162.
  - II. Claims 17 29, drawn to a photochromic lens, classified in class 359, subclass 581.
- 2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process of making and product made, respectively. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process, such as (1) a process in which a preformed photochromic elastomer film is laminated onto a lens (i.e., a process that does not include coating a lens with a solution of a pre-polymer of an elastomer having a photochromic dye dissolved therein), or (2) coating a lens with an elastomeric film and then diffusing / injecting a photochromic dye into the deposited film (i.e., a process that does not include dissolving a photochromic dye in a solution containing a pre-polymer of an elastomer).
- 3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and

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recognized divergent subject matter, restriction for examination purposes as indicated is proper.

- 4. A telephone call was made to Mr. Charles Guttman on 7/8/2003 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement, to be complete, must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).
- 5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

## Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (703) 308-7557. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Wesley D Markham Examiner Art Unit 1762

**₩DM** July 8, 2003

TIMOTHY MEEKS
PRIMARY EXAMINER